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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,850	06/19/2000	Edward A. Marue	546-P-8-USA	4479

7590 06/12/2003

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EXAMINER

RAMIREZ, RAMON O

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 06/12/2003

#31

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 31

Application Number: 09/596,850
Filing Date: June 19, 2000
Appellant(s): MARUE ET AL.

David G. Duckworth
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 2, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-7 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 stand rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

A broadening aspect is present in the reissue, which was not present in the application

08/353,118, issued as Pat. No. 5,615,855 (hereinafter the '855 patent). The record of this application shows that the broadening aspect relates to subject matter that appellant previously surrendered during the prosecution of the '855 patent. Accordingly, the narrow scope of the claims in the '855 patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application cannot be recaptured by the filing of the present reissue application.

The limitation "a payload located only on the top portion telescopic mast" omitted in the reissue claims was present in the claims of the '855 patent. Appellant indicated through the prosecution of the patent application that this was the main reason for allowance. The examiner's reasons for allowance in the '855 patent application stated that it was the

limitation of the *top section being fully retracted* which distinguished over the art of record. Appellant did not present on the record a counter statement or comment as to the examiner's reason for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered. This rejection was also presented during the prosecution of re-issue application 09/283,843 which is a parent application for this application, and was not traverse by Appellant, who proceeded to amend the claims to include the above language.

(11) *Response to Argument*

Appellant argues that the Recapture Rule bars only claims that are of the same or broader scope that those claims that were cancelled from the original application. The examiner disagrees as to the Recapture Rule applies to all the claims, not only to the cancelled claims. Appellant cites three court decisions. The examiner will refer only to Pannu v. Storz, which is the latest one. Nothing in this decision indicates that the Recapture Rule applies only to the cancelled claims. A review of Appellant's arguments appears to show that Appellant argument is based in conclusions and not in facts.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

RAMON O. RAMIREZ
Primary Examiner
Art Unit 3632

R.O.Ramirez
June 9, 2003

Conferees
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